

Applicant wishes to take this opportunity to thank the Examiner for reconsidering the prior election of species requirements and reinstating claims 85-87, 91-97, 99-103, 105-107, 109-114, 116, 117, 120-124, 128-130, 134-140, 142-146, 148-150, 152-157, 159-160, 163-167, 171-176, 178-181, 183-185, 187-190, 192, 194-198, 205-209, 211-214, 216-218, 220-223, 225, 227-230, 234-239, 241-244, 246-248, 250-253, 255, 257-261, 268-277, 279-281, 283-286, 288, 290-293, 302-307, and 326-331 for examination on the merits.

Applicant also wishes to thank the Examiner and the Special Program Examiner, Mr. Henry Yuen, for taking time to discuss the outstanding rejections with Applicant's representative during the telephone conferences held on November 4, 2008 and November 5, 2008, respectively. During those conferences, the Examiners indicated that, during preparation of the August 5, 2008 Office Action, the Examiners did not consider Applicant's Response to Final Office Action filed June 20, 2008, and the Examiners also acknowledged that the August 5, 2008 Office Action does not have any written remarks responsive to the remarks in the previously filed June 20, 2008 Response. The Examiners then suggested that Applicant submit a response to the present Office Action, with the same remarks presented in the June 20, 2008 Response, in order to facilitate having the Examiners consider those remarks. Therefore, as suggested by the Examiners, Applicant submits the following remarks, most of which have been previously presented in the June 20, 2008 Response.

In the Office Action, the Examiner rejected all of the examined claims, except the allowed claims, under 35 U.S.C. §§ 102(b) and 103(a) based on U.S. Patent No. 4,403,624 to Montgomery ("Montgomery"). In addition to the art rejections, the

Examiner rejected, under 35 U.S.C. § 251, claims 84-339 as being an alleged improper recapture and claims 30-83 as allegedly containing “[sic] 35 USC 251 no error.” The Examiner further alleged that the reissue declarations filed on October 29, 2001 and December 21, 2006 are defective. Applicant respectfully traverses all of these rejections for the reasons explained below.

### **35 U.S.C. § 102(b) Rejection**

In the final Office Action, the Examiner rejected claims 84-89, 91-97, 99-103, 105-107, 109-114, 116, 117, 120-132, 134-140, 142-146, 148-150, 152-157, 159, 160, 163-176, 178-181, 183-185, 187-190, 192, 194-203, 205-209, 211-214, 216-218, 220-223, 225, 227-239, 241-244, 246-248, 250-253, 255, 257-266, 268-277, 279-281, 283-286, 288, 290-295, 302-307, and 326-335 under 35 U.S.C. § 102(b) as allegedly being anticipated by Montgomery. See paragraph 2 of Office Action.

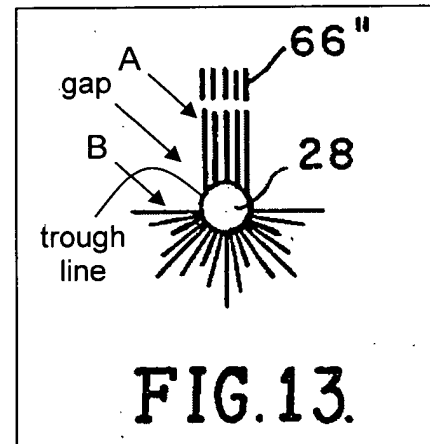
As an initial matter, Applicant notes that some of the rejected claims were also rejected under 35 U.S.C. § 103(a) based on Montgomery. See paragraph 5 of Office Action. Since a claim cannot be properly rejected under both 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) based on the same prior art, either the § 102(b) rejection or the § 103(a) rejection is clearly improper with respect to those overlapping claims.

Applicant respectfully requests that the Examiner clarify this inconsistency in the next Official communication to Applicant.

For the following reasons, Applicant respectfully disagrees with the claim rejection under 35 U.S.C. § 102(b).

Montgomery discloses applicators for applying cosmetics to the eye lashes. The Examiner's rejection relied on the embodiment shown in Figs. 11-13, which discloses an

applicator that includes a handle portion 26, a rod 28 extending from the handle portion 26, and a brush portion located on an end of the handle portion 26. The brush portion includes teeth 66" affixed to the rod 28. The Examiner asserted that the handle portion 26 and the teeth 66" of Montgomery correspond to the recited "elongated core" and "bristles," respectively. In addition, the Examiner asserted that "the gap between the bristles" corresponds to the recited "notch" and that the side faces of the teeth 66" (see "A" and "B" shown in annotated Fig. 13 above) correspond to the recited "front face" and "back face," respectively. Also, the Examiner asserted that side faces "A" and "B" intersect one another at "the line that divides the bristles."



Without necessarily acquiescing to the Examiner's characterizations of Montgomery, Applicant submits that, even assuming, *arguendo*, that side faces "A" and "B" intersect at "the line that divides the bristles," that line is not "spaced away from the core," as recited in each of independent claims 84, 127, 170, 201, 233, 264, and 332-335. Instead, the alleged "line that divides the bristles" is on the rod 28, as clearly shown in Fig. 13.

Nonetheless, without even providing any factual support or any logical explanation, the Examiner alleged that "[a] gap is formed between the bristles and that gap is space[d] away from the core" (Office Action at 18) and maintained this 35 U.S.C. § 102(b) rejection. While it is questionable as to what the Examiner intended to convey with this statement about the purported "gap," Applicant notes that the statement is

completely irrelevant. For example, each of independent claims 84, 127, 170, 201, 233, 264, and 332-335 recites that the trough line at which the front and back faces intersect is “spaced away from the core.” That is, the claims recite that it is the trough line, not a “gap,” that is spaced away from the core. Therefore, whether or not a “gap” is spaced away from the core in Montgomery is completely irrelevant in determining whether Montgomery has any trough line that is spaced away from a core.

With respect to previously withdrawn claims 85-87, 91-97, 99-103, 105-107, 109-114, 116, 117, 120-124, 128-130, 134-140, 142-146, 148-150, 152-157, 159-160, 163-167, 171-176, 178-181, 183-185, 187-190, 192, 194-198, 205-209, 211-214, 216-218, 220-223, 225, 227-230, 234-239, 241-244, 246-248, 250-253, 255, 257-261, 268-277, 279-281, 283-286, 288, 290-293, 302-307, and 326-331, the Examiner failed to specifically point out how Montgomery purportedly discloses each and every element recited in those claims. Instead, the Examiner merely copied the language of the claims without supplying any sufficient reasoning for the rejection. Due to this lack of sufficient reasoning, Applicant is unable to ascertain the Examiner’s rejection reasons as applied to those claims and hence unable to respond to the rejection of each claim. Presently, without discussing each and every subject matter of those claims in detail, Applicant submits that at least certain of those claims independently define patentable subject matter over Montgomery. Applicant thus reserves the right to present further arguments with respect to the rejection of those claims upon further clarification of the rejection reasons by the Examiner. In order to enable Applicant to fully respond to the Examiner’s rejection of those previously withdrawn claims, Applicant respectfully

requests the Examiner to provide sufficient rejection reasons in the next Official communication to Applicant.

For at least these reasons and other reasons set forth in Applicant's prior response filed May 16, 2007, Applicant continues to submit that the claims patentably distinguish from Montgomery. Thus, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b) based on Montgomery.

### **35 U.S.C. § 103(a) Rejection**

The Examiner also rejected claims 94, 95, 99, 100, 107, 110-113, 137, 138, 142, 143, 150, 152-156, 174, 178, 185, 188, 189, 207, 211, 218, 221, 222, 237, 241, 248, 251, 252, 270, 274, 281, 284, 285, and 336-339 under 35 U.S.C. § 103(a) based on Montgomery. See paragraphs 4 and 5 of Office Action.

Each of the rejected claims depends either directly or indirectly from one of independent claims 84, 127, 170, 201, 233, 264, and 332-335. Therefore, all of the rejected claims also patentably distinguish from the disclosure of Montgomery at least by virtue of their respective dependency from independent claims 84, 127, 170, 201, 233, 264, and 332-335. Thus, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 103(a) based on Montgomery.

### **35 U.S.C. § 251 Rejections**

The Examiner rejected claims 84-339 under 35 U.S.C. § 251 as being an alleged improper recapture of subject matter surrendered during prosecution of the application that matured into U.S. Patent No. 5,918,994 ("parent patent"). Specifically, the Examiner alleged that, during prosecution of the parent patent, Applicant purportedly amended the original claims to add the recitations "non-concave notch back" and "two

secant faces of the notch [being] asymmetric and [forming] a trough line” and allegedly argued the importance of these added recitations. See pages 15 and 16 of Office Action. Based on these allegations, the Examiner alleged that claims 84-339 attempt to recapture surrendered subject matter because the claims omit the same claim limitations added in the application that matured into the parent patent. Applicant respectfully disagrees with the Examiner’s allegations.

The Examiner appears to be alleging that the features of a non-concave notch back and two secant faces being asymmetric and forming a trough line have been surrendered because they were either added in claim amendments or argued in remarks submitted in the application that matured into the parent patent. Even assuming, *arguendo*, that these features were indeed surrendered (a notion that Applicant does not necessarily agree with), Applicant notes that there still can be no recapture since reissue claims 84-339 recite all of these allegedly surrendered features. More specifically, independent claims 84, 127, 170, 201, 233, 264, 332, 333, 334, and 335 each include the allegedly surrendered features as follows:

Claim 84:

- “the at least one notch comprising a front face and a back face, the back face being non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of the at least one notch intersect one another at a trough line”

Claim 127:

- “the at least one notch comprising a front face and a back face, the back face being at least in part non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of the at least one notch intersect one another at a trough line”

Claim 170:

- “the at least one notch comprising a front face and a back face, the back face being non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of the at least one notch intersect one another at a trough line”

Claim 201:

- “the at least two notches each comprising a front face, a back face, and a trough line, the back face being non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of each of the at least two notches intersect one another at the trough line”

Claim 233:

- “the at least one notch comprising a front face and a back face, the back face being at least in part non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of the at least one notch intersect one another at a trough line”

Claim 264:

- “the at least two notches each comprising a front face, a back face, and a trough line, the back face being at least in part non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of each of the at least two notches intersect one another at the trough line”

Claim 332:

- “the at least two notches each comprising a front face, a back face, and a trough line, the back face being non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of each of the at least two notches intersect one another at the trough line”

Claim 333:

- “the at least two notches each comprising a front face, a back face, and a trough line, the back face being at least in part non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of each of the at least two notches intersect one another at the trough line”

Claim 334:

- “the at least two notches each comprising a front face, a back face, and a trough line, the back face being non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of each of the at least two notches intersect one another at the trough line”

Claim 335:

- “the at least two notches each comprising a front face, a back face, and a trough line, the back face being at least in part non-concave and asymmetric with respect to the front face”
- “wherein the front and back faces of each of the at least two notches intersect one another at the trough line”

As such, Applicant submits that the Examiner's allegation that the claims omit the same limitations added in the application for the parent patent is unsupportable. For at least these reasons, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 251 should be withdrawn.

Worth noting is the Examiner's additional allegation that “[t]he criticality of such ‘two asymmetric faces [forming] a reentrant angle beta at trough line’ is also discussed.” See page 16 of Office Action. It is unclear whether the Examiner is alleging that the feature of forming a “reentrant angle” is another example of purportedly surrendered subject matter. Nonetheless, Applicant notes that this feature was neither added nor argued during prosecution of the application for the parent patent and, therefore, should not be subject to the recapture rule. For example, in support of his allegation, the Examiner appears to have relied on remarks filed by Applicant on September 24, 1998 and also the Examiner's statement of reasons for allowance of November 19, 1998.

Applicant notes, however, that neither the September 24, 1998 remarks by Applicant nor the Examiner's statement includes any comment reflecting the so-called “criticality” of two asymmetric faces forming a reentrant angle at a trough line. To the



contrary, the only mention of the two asymmetric faces forming a reentrant angle at a trough line appears in the paragraph bridging pages 4 and 5 of Applicant's September 24, 1998 remarks, which is reproduced below in its entirety:

New independent Claims 32 and 35 [] are based upon the original Claims 1 and 31 but do not include certain unnecessary limitations. These claims are also believed to define over the prior art since they recite that the two secant faces of the notch are "asymmetric" (see page 2, line 11) and form a "trough line." For example, the two asymmetric faces of Figure 1A form a reentrant angle  $\beta$  at the trough line 107, but only the second face forms the emergent angle  $\alpha$  with the envelope surface of the brush. This contributes to the formation of open notches giving access to the trough line, which holds the greatest amount of product, and promotes spreading (page 3, lines 16-21). (Emphasis added)

As is abundantly clear, the paragraph refers to the feature of "the two asymmetric faces of Figure 1A form[ing] a reentrant angle" merely to show an example of how the specification provides support for the recited features of "asymmetric" and forming a "trough line." That is, contrary to the Examiner's allegation, there is no discussion of the so-called "criticality" of having a reentrant angle at a trough line. Nor is there any mention of such a feature being necessary to distinguish over the cited prior art.

With respect to the Examiner's statement of reasons for allowance, Applicant notes that the statement does not mention anything about the "reentrant angle." Even if it did, the Examiner's statement of reasons for allowance cannot, by itself, provide the basis for establishing surrender and recapture. See, e.g., M.P.E.P. § 1412.02 I.B.2(C), entitled "Example (3) - Who can make the surrendering argument?" For at least these reasons, the feature of the two asymmetric faces forming a reentrant angle at a trough line is not subject to surrender or recapture in this reissue application.

For the reasons set forth above, Applicant respectfully submits that the Examiner's rejection of claims 84-339 under 35 U.S.C. § 251 is in error and should be withdrawn.

The Examiner also rejected claims 30-83 under 35 U.S.C. § 251, alleging that merely adding dependent claims 30-83 without changing the scope of independent claims is not a correction of a § 251 error. Notwithstanding the Examiner's failure to cite any authoritative basis for his allegation, Applicant submits that 35 U.S.C. § 251 clearly sets forth that "[w]henver any patent is ... deemed wholly or partly inoperative or invalid ... by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall ... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application." (Emphasis added.) That is, correcting patent claims in a reissue application by adding claims that are narrower than the original patent claims is one of the valid and proper grounds for filing a reissue application. See *e.g.*, M.P.E.P. §§ 1402 and 1414. Each of dependent claims 30-83 has a scope narrower than that of patent claim 1 and, thus, adding claims 30-83 is completely consistent with 35 U.S.C. § 251. For at least this reason, Applicant respectfully submits that this rejection under 35 U.S.C. § 251 is in error and should be withdrawn.

#### **Alleged Defective Reissue Declaration**

The Examiner also alleged that the reissue declarations filed on October 29, 2001 and December 21, 2006 are defective because they fail to properly identify at least one 35 U.S.C. § 251 error. Specifically, the Examiner alleged that the statement in paragraph 6 of the declarations is insufficient because any error in the claims must be

identified by reference to the specific claim(s) and the specific claim language wherein lies the error. The Examiner also alleged that “[t]he differences between the newly added claims 30-339 and the original claims 1-29 must be pointed out.” Applicant disagrees with these allegations for at least the following reasons.

Paragraph 6 of the reissue declaration states that:

Independent claim 1 of U.S. Patent No. 5,918,994 recites a brush comprising, *inter alia*, at least one notch comprising at least two secant faces that “form a reentrant angle ( $\beta$ ) of between 60° and 180° at any point along” a [trough] line. Certain aspects of the invention could be practiced without having such a configuration.

As is abundantly clear, this statement identifies an error with the required specificity. In particular, in contrast to the Examiner’s allegations, the statement identifies the error by a clear reference to the specific claim (i.e., claim 1) and the specific claim language (i.e., “form a reentrant angle ( $\beta$ ) of between 60° and 180° at any point along” a trough line). The statement also identifies how the error renders the original patent wholly or partly inoperative or invalid (i.e., “Certain aspects of the invention could be practiced without having such a configuration”).

Regarding the Examiner’s allegation that Applicant must identify the differences between newly added claims 30-339 and the original claims 1-29, Applicant notes that the Examiner appears to have misunderstood the specificity requirement of a reissue declaration. Identifying the differences between the claims being added in the reissue application and the original patent claims, as proposed by the Examiner, would require, in effect, identification of all of the errors and the corresponding corrective actions being taken. However, there is no such requirement for identifying all of the errors being corrected or the corrective actions being taken in a reissue declaration. As 37 C.F.R.

§ 1.175(a)(1) clearly sets forth, a reissue applicant need only identify one of the errors in the reissue declaration. Also, the corrective action which has been taken in the reissue application to correct the original patent need not be identified in the declaration. Once the reissue applicant identifies one such error, as Applicant did in this case, this requirement is satisfied. See *e.g.*, M.P.E.P. § 1414 II.(B). For at least these reasons, Applicant respectfully submits that the Examiner's allegation is unfounded and should be withdrawn.

### **Supplemental Declaration**

The Examiner required submission of a supplemental declaration to cover the errors corrected by Applicant's amendments filed May 16 and June 28, 2007. In response, Applicant had previously submitted a Supplemental Declaration, as required by the Examiner, on June 20, 2008 as an Attachment to the Response to Final Office Action. In the Supplemental Declaration, although not required, Applicant has added a paragraph stating that "U.S. Patent No. 5,918,994 is also partially inoperative by reason of my having claimed more than I had a right to claim in certain aspects" to cover the errors being corrected by adding dependent claims 30-83. Applicant respectfully requests the Examiner to consider the Supplemental Declaration filed on June 20, 2008, and to withdraw the requirement for any further declaration.

### **Conclusion**

In view of the foregoing reasons, Applicant respectfully requests reconsideration of this application, withdrawal of all of the outstanding rejections, and allowance of all of the pending claims.

The Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicant declines to necessarily subscribe to any statement or characterization in the Office Action, regardless of whether it is addressed above.

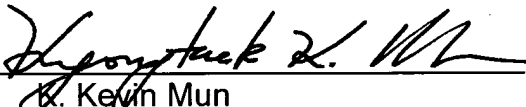
Should the Examiner believe a telephone conversation might advance prosecution of this case, he is invited to call the undersigned at 571-203-2739.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: December 4, 2008

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